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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,343	12/20/2001	Ratan K. Chaudhuri	EMI 29	2576

23599 7590 03/20/2002

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
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ARLINGTON, VA 22201

EXAMINER

REYES, HECTOR M

ART UNIT	PAPER NUMBER
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1623

DATE MAILED: 03/20/2002

2

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,343

Applicant(s)

CHAUDHURI, RATAN K.

Examiner

Hector M Reyes

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 6 and 11 to 33 is/are rejected.
- 7) ☒ Claim(s) 7 to 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 3, 4, 5, 11, 12, 13, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 30, 31, 32, 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Preuss et al, US patent 4,284621.

Preuss discloses the preparation of a series of compounds useful in the preparation of compositions directed to protect the skin against UV radiation to a greater or lesser extent (col. 1, lines 1 to 27). Among the compounds disclosed by Preuss are:

- 4-hydroxy-3-methoxybenzylidenemalonic acid diethyl ester and
- 4-hydroxy-3-methoxybenzylideneacetoacetic acid ethyl ester (see Table 1.

Such compounds are used in cosmetic agents and in dermatology. Such compounds:

- have an absorption maximum at 340 (col. 1, lines 48),
- show stability to UV radiation (col. 1, line 56),
- show stability to oxidation (col. 1, line 57),
- are used in a concentration of 0.2 to 10% in addition to others customary cosmetic or dermatological ingredients, including iron oxides (col. 6, lines 33 to 55) and UV –B filters (col.6, lines 59-62) and an extensive list of other agents (see col. 6, lines 1 to 4 and 29 to 32 and Examples 1 to 6).

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- constitute agents for protection against sunlight, such as oils, and lotions (col. 5, lines 62 to 64).

Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Manrao et al, CA 101:85528 abstract for Pesticides, 1984, 18 (2) pages 30 to 36.

Manrao discloses a series of ferulic acid derivatives. Among them, the diamide derivative of 4-hydroxy-3-methoxy bezylidenemalonate (see compound wherein R1 and R2 are both an amide).

### **Claim Objections**

Claims 7, 8, 9 and 10 are objected because such claims depend on rejected claims.

Claim 7 depends on rejected claim 3. Claim 8 depends on rejected claim 2. Claim 9 and 10 depend on objected claim 8, which depends on rejected claim 2. The particular compounds described on such claims 7, 8, 9, and 10 were not found disclosed or suggested in the prior art.

### **CONCLUSION**

Any inquiry concerning this communication should be directed to Hector M. Reyes whose telephone number is (703) 605-1153. The examiner can normally be reached on Monday to Friday from 8 am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Killos, whose telephone number, is (703) 308-0135. The fax phone number for the organization where this application or proceeding is assigned is (703)

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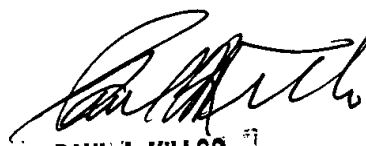
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308-4556 or for regular communication and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of the application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
3-18-02

  
PAUL J. KILLOS  
PRIMARY EXAMINER  
AY.1623